

AMENDMENT AND REQUEST FOR RECONSIDERATION
UNDER 37 C.F.R. § 1.111
U.S. Application No.: 10/533,240

Attorney Docket No.: Q87659

REMARKS

Applicant respectfully **traverses** the rejections of the remaining claims under 35 U.S.C. § 103(a) as set forth in paragraphs 3 and 4 of the Office Action.

Applicant cancels without prejudice all claims directed to the Fig. 5 embodiment, i.e., with inwardly directed deformations.

A most significant exemplary embodiment of the present invention, namely the pack pursuant to Fig. 1, Fig. 2, Fig. 4, Fig. 8, Fig. 10..., with outwardly directed round projections 35, is essentially characterized by the following design:

An essentially cuboid-shaped hinge-lid pack having in the region of the upright longitudinal edges projections which extend outwardly beyond the contour of the pack and which have a three-quarter circular-shaped cross-section.

The projections 35 formed by material deformation or embossing of the packaging material act as “supporting columns” at the four pack corners. An essential factor is the increased dimensional stability of the pack made of thin cardboard. In addition, this measure creates a special aesthetic shape. Finally, consumer handling of the pack is made easier because the round projections make the pack easy to be held in one’s hand. It lacks the sharp, right-angled pack edges of a conventional hinge-lid pack, which make it more difficult to handle the pack.

The Office Action derives from the Brizzi pack its most important argument against the patentability of a pack configured in the manner just described. The preceding Office Action already pointed out that the drawings represented in Fig. 3a, Fig. 3b of Brizzi are confusing

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because the contours of the folding lines are not represented to scale in a realistic manner. On this point the (most recent) Office Action states on page 2/page 3:

.. the longitudinal edges and/or transverse edges are configured by the deformation or embossing of the packaging material as an outwardly directed projection (see Fig. 3) having a round cross-section.

The statement that the folding lines pursuant to 17d in the representation of Fig. 3 are directed outwardly is incorrect. In configuring the design of hinge-lid (cigarette) packs, it is a common and fundamental standard that the folding lines be configured to be directed **inwardly**. Applicant has a blank of the "Davidoff" cigarette brand. The blank is used to produce hinge-lid packs having beveled pack edges (corresponding to US patent 4 753 384 to Focke which is of record). Compared to Focke '384, the blank for the Davidoff pack is slightly modified, superficially with respect to the configuration of the "corner tabs" which correspond to the folding tabs 22 of the blank of Brizzi. But what is decisive is the configuration of the beveled edges or the embossed lines for the folding edges that are applied to the blank. These are recognizably directed inwards. Naturally, this also applies to transverse embossed lines for forming transverse folding edges.

Applicant also has a blank for a standard hinge-lid pack, specifically one for the brand "West". This blank confirms the assertion that in these packs, it is standard that embossed lines for folding edges are directed inwardly.

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This also has the effect that, when the folding lines defined by the embossed lines are folded, no projections are generated at the outer side of the pack. Instead, due to the described embodiment of the embossed lines, the folding edges on the outer side of the pack correspond very precisely to the right-angle contour or to the obtuse-angle contour (Brizzi). For this reason, the folding lines 13 in the drawing of the finished, closed pack in Fig. 2 of Brizzi are shown as simple lines without any outwardly-directed contour.

A person skilled in the art would therefore not be able to find any suggestions from Brizzi which would lead to a design of hinge-lid pack within the meaning of claim 24. On the contrary: The knowledge of the person of the structure and arrangement of folding lines in a standard hinge-lid pack and in the Brizzi pack would directly lead the person away from the solution claimed by Applicant.

GB 819 206 to Jackson, viewed either on its own or in combination with Brizzi, fails to lead to any different conclusion.

Jackson was discussed in detail in the response to the previous Office Action. Jackson differs from the claimed invention in a number of features: The basic structure is significant to the respect that Jackson employs a single-piece blank in which the collar is a component of the single-piece blank (page 1, last line). The upper part of the box, usually designated as a collar, comprises front wall 12 and side panels 13. These are encompassed by the lid when the pack is closed. If the blank (including the lid) has the contour and dimensions taken from Fig. 4 of

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Jackson, for geometric reasons it is not possible for the lid to encompass the collar or its panels 12, 13. For this reason the panels 12 and 13 are set back so that they can be encompassed by the lid (remarks page 2, line 21 to 34 of Jackson).

Corner portions 16 of the panels 12, 13 are configured as projections. Their contour is described as "*arcuate or semi-tubular*" (page 2, lines 53, 54). However, of decisive importance of the construction and function of these corner portions 16 is that, according to the specific representation in Jackson, they extend as a continuation of the edges between the walls 2 and 3 of the pack, i.e. in continuation of the upright (right-angle) pack edges (page 2, lines 43 to 49). This is also essential because without this requirement the lid cannot be moved into its closed position. Contrary to the assertion made in the Office Action (page 5, third line) Jackson does not provide a "*rounded projection of a three-quarter circle*". This is shown by the above quote in line 54.

A combined view of Brizzi and Jackson does not lead to the desired goal due to their different constructive designs and their respective technical backgrounds. To create folding lines, Brizzi employs inwardly directed embossed lines created solely by material deformation. Jackson shows outwardly directed round edges, which arise by the necessary embossing of collar panels in a single-piece blank. The embossments of Brizzi, on one hand, and the edge deformation of Jackson, on the other hand, technically have nothing in common, so that even an

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expert in the art would not be able to reconcile the two differing design details with each other, or even apply them in combination within the meaning of the claimed invention.

With respect to its technical information, the newly introduced US 941 356 to Byrne is comparable to US 3 240 845 to Voelker. A convincing counter-argument to this reference was acknowledged in the Office Action (bottom of page 6 /top of page 7). The previous arguments directed at Voelker essentially apply to Byrne as well.

Byrne employs a special packaging material comprising a plurality of layers, namely outer layers 6, 7 made of paper and a core layer of burlap. With the details in Fig. 3 and Fig. 4, Byrne attempts represent a folding of this multi-layer material. To this end, embossments are provided in the region of a folding line 9 (Fig. 3). When the walls are folded to assume a right-angle position to one another (Fig. 4) the burlap core layer 8 is detached from the outer paper layer 6 (page 1, lines 91 to 96). This shape is shown in Fig. 4. The technical background of this solution is the low tear strength of the paper layer. If the adhesive connection of all layers would be maintained in the region of the folding edges, i.e. if the connection between the outer paper layer 6 and the core layer 8 were not detached, the paper layer would tear. This therefore creates an outer rounding by the paper layer 6 and an inwardly directed bulge by the layers 7 and 8. However, this is a constructive design that is not employed to create a special contour of a pack but which arises from the behavior of the material to enable the folding of a multi-layer structure of the packaging material. The inwardly directed, round projection in the region of the folding

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line 9 is likewise not created by embossing the material for creating the rounding, as is shown in Applicant's Fig. 8, Fig. 9. The difference between the two technologies here becomes more clear when Applicant's Fig. 8 is compared to Fig. 3 of Byrne. Shown in both cases are folding tabs in their extended position. In Fig. 8, the embossment 46 is already created. In Byrne the material is essentially in a continuous extended position.

Thus, it is clear that the combined teachings of the references relied upon by the Examiner do not disclose or even suggest **all the limitations** of claim 24 and its dependent claims, whereby these references are **incapable** of rendering the obvious the subject matter of these claims within the meaning of 35 U.S.C. § 103(a).

Thus, Applicant respectfully requests the Examiner to reconsider and withdraw the rejections under 35 U.S.C. § 103(a). If the Examiner does not feel that the application is now in condition for allowance, he is respectfully requested to call the undersigned attorney to discuss the matter, including other claim amendments which the Examiner may feel are necessary.

Applicant files concurrently herewith a Petition (with fee) for Extension of Time of three months.

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Respectfully submitted,

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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: March 25, 2010